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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

AUVE, G

ART UNIT

PAPER NUMBER

2781

DATE MAILED:

08/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/224,626

Applicant(s)

Marisethy

Examiner

Glenn Anne

Group Art Unit

2781

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-50 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2781

DETAILED ACTION

Reissue Applications

1. The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.
2. It would be acceptable for a person, other than a recognized officer, to execute a submission establishing ownership interest, provided the record for the application includes a statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the organization.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

3. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

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5. Claims 1-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. Claims 36-50 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In this case, applicant's new claims do not include the "virtual device driver" limitation which the examiner indicated as the allowable subject matter in the parent patent, and which applicant argued as the feature which made the claims allowable over the prior art used in the rejections in the parent application (see applicant's amendment A, pages 5-6, filed 5/28/96 in the parent patent application). Applicant had also added this limitation to claim 11 in order to overcome the art rejection and included it in the claims added in amendment A. The Courts have ruled that such broadening of the claims in a reissue application violates the "recapture rule", see *Hester Industries Inc. V. Stein Inc.*, 46 USPQ2d 1641 (Fed. Cir. 1998). Therefore, applicant's claims are rejected as being an improper recapture.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 36-38, 41-43, and 46-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al., U.S. Pat. No. 5,167,024.

As per claim 36, Smith et al. (Smith) shows monitoring activity of a device; detecting the device being inactive for a predetermined period of time; placing the device in a reduced power consumption state in response to detected inactivity (all at least in the abstract and cols. 7 and 9); and managing the device to allow more than one application to use the device (inherent in that any personal computer system has plural application programs utilizing the I/O devices and disk drives). Smith shows all of the elements recited in claim 36.

As for claim 37, the argument for claim 36 applies. Smith also shows that the instructions are a device driver (col. 9). Smith shows all of the elements recited in claim 37.

As for claim 38, the argument for claim 37 applies. Smith also shows that the device is an I/O device (throughout the specification). Smith shows all of the elements recited in claim 38.

As per claim 41, Smith et al. (Smith) shows monitoring activity of a device; detecting the device being inactive for a predetermined period of time; placing the device in a reduced power consumption state in response to detected inactivity (all at least in the abstract and cols. 7 and 9);

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and managing the device to allow more than one application to use the device (inherent in that any personal computer system has plural application programs utilizing the I/O devices and disk drives). Smith shows all of the steps recited in claim 41.

As for claim 42, the argument for claim 41 applies. Smith also shows that the instructions are a device driver (col. 9). Smith shows all of the steps recited in claim 42.

As for claim 43, the argument for claim 42 applies. Smith also shows that the device is an I/O device (throughout the specification). Smith shows all of the steps recited in claim 43.

As per claim 46, Smith shows a bus (fig. 1); a memory coupled to the bus (fig. 1); a first device coupled to the bus (fig. 1); a processor coupled to the bus (12); and a second device having stored thereon a set of instructions which manage the first device to allow more than one application to use the device and monitor activity of the first device, and in response to the first device being inactive for a predetermined period, place the first device in a reduced power state (11). Smith shows all of the elements recited in claim 46.

As for claim 47, the argument for claim 46 applies. Smith also shows that the instructions are a device driver (col. 9). Smith shows all of the elements recited in claim 47.

As for claim 48, the argument for claim 47 applies. Smith also shows that the device is an I/O device (throughout the specification). Smith shows all of the steps recited in claim 48.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 39,40,44,45,49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Stewart, U.S. Pat. No. 5,404,546.

As for claims 39,44, and 49, the arguments above for claims 38,43, and 48 apply. Smith does not specifically mention checking event timers at regular intervals. However, Stewart does specify the use of idle timers for each device (col. 4, lines 64-68). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the timers of Stewart in the system of Smith in order to provide predictable time periods for the various timeout functions.

As for claims 40,45, and 50, the arguments above for claims 39,44, and 49 apply. Smith does not specifically mention checking event timers at regular intervals. However, Stewart does specify the use of idle timers for each device (col. 4, lines 64-68). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the timers of Stewart in the system of Smith in order to provide predictable time periods for the various timeout functions.

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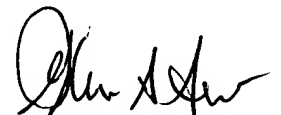
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn Auvé whose telephone number is (703) 305-9638. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703) 305-9648. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Glenn A. Auvé
August 9, 1999


GLENN A. AUVE
PRIMARY EXAMINER

Ball Corporation v. United States

(CA FC)

221 USPQ 289

Decided Mar. 15, 1984

No. 84-680

U.S. Court of Appeals Federal Circuit

Headnotes

PATENTS

1. Reissue -- In general (§ 58.1)

Reissue is not substitute for PTO appeal procedures; reissue is extraordinary procedure and must be adequately supported by circumstances detailed in 35 USC 251 and in implementing regulations, 37 CFR 1.175.

2. Reissue -- Inadvertence, accident and mistake (§ 58.3)

1952 revision of patent laws made no substantive change in definition of error under 35 USC 251; error is interpreted in same manner as under Section 64 of old law, that is, accident, inadvertence, or mistake; deliberate cancellation of claim cannot ordinarily be considered error.

3. Reissue -- Inadvertence, accident and mistake (§ 58.3)

CAFC declines to adopt rigid standard for construing error applied in *Riley v. Broadway-Hale Stores, Inc.*, 103 USPQ 414, in favor of more liberal approach taken by CCPA.

4. Construction of specification and claims -- By Patent Office proceedings -- Comparison with cancelled claims (§ 22.157)

Reissue -- Inadvertence, accident and mistake (§ 58.3)

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Claim scope is no oracle on intent; since rarely is evidence of patentee's intent in cancelling claim presented, court may draw inferences from changes in claim scope when other evidence of patentee's intent is not available; claim scope is not lodestar of reissue; rather, court's reliance on that indicator is born of practical necessity as only available reliable evidence.

5. Reissue -- In general (§ 58.1)

Recapture rule bars patentee from acquiring, through reissue, claims that are of same or of broader scope than those claims that were cancelled from original application; on other hand, patentee is free to acquire, through reissue, claims that are narrower in scope than cancelled claims; if reissue claims are narrower than cancelled claims, yet broader than original patent claims, reissue must be sought within 2 years after grant of original patent.

6. Reissue -- In general (§ 58.1)

Reissue -- Inadvertence, accident and mistake (§ 58.3)

Applicability of recapture rule and sufficiency of error under 35 USC 251 turn, absent other evidence of patentee's intent, on similarity between reissue and cancelled claims; narrower reissue claims are allowable; broader reissue claims or reissue claims of same scope as cancelled claims are not; subject matter of claims is not alone controlling; similarly, focus is not on specific limitations or on elements of claims but, rather, on scope of claim.

7. Reissue -- In general (§ 58.1)

Argument -- that standard requiring patent challenger to establish that applicant made deliberate decision that its cancelled claims were unpatentable is not correct because it loses sight of feature that patentee gave up during prosecution of original application -- is unpersuasive; proper focus is on scope of claims, not on individual feature of element purportedly given up during prosecution of original application.

8. Reissue -- In general (§ 58.1)

Claim that is broader in any respect is considered to be broader than original claim even though it may be narrower in other respects; principle effects 35 USC 251 bar against reissue filed later than 2 years after issuance of original patent.

9. Construction of specification and claims -- Broad or narrow -- In general (§ 22.101)

Reissue -- In general (§ 58.1)

Reissue -- Inadvertence, accident and mistake (§ 58.3)

Rule that claim is broadened if it is broader in any respect than original claim is rigid and properly so in that it effects express statutory limitation on broadened reissue; recapture rule, however, is based on equitable principles; CAFC declines to apply broader-in-any-respect rule where broader feature relates to aspect of invention that is not material to alleged error supporting reissue; extent to which deliberate cancellation of claim from original application may also prevent patentee from obtaining other claims differing in form or substance from that cancelled necessarily depends upon facts in each case and particularly on reasons for cancellation.

10. Reissue -- Inadvertence, accident and mistake (§ 58.3)

Non-material, broader aspects of reissue claims that do not deprive them of their fundamental narrowness of scope relative to cancelled claims, so that they are sufficiently narrower than cancelled claims, avoid effect of recapture rule.

11. Estoppel -- In general (§ 35.01)**Reissue -- In general (§ 58.1)**

Recapture rule is creature of equity and embodies estoppel notion that deliberate nature of patentee's acts bars it from securing through reissue, claims similar to claims it cancelled; reissue is remedial in nature and is based on fundamental principles of fairness and equity; recapture rule is inherently founded on similar considerations of equity, providing guidance in application of law governing reissue.

12. Construction of specification and claims -- By Patent Office proceedings -- In general (§ 22.151)**Infringement -- Substitution of equivalents -- In general (§ 39.71)**

Doctrine of estoppel based on prosecution history is corollary to doctrine of equivalents, a tool in analysis of infringement.

Case History and Disposition:

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Appeal from United States Claims Court, Colaianni, J.; 219 USPQ 73

Petition by Ball Corporation, against the United States, for compensation for use of patented invention. From order denying

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motion for summary judgment, defendant appeals. Affirmed.

Attorneys:

Joseph A. Hill, Washington, D.C., for appellant.

Allen Kirkpatrick, Washington, D.C., for appellee

Judge:

Before Baldwin, Bennett, and Smith, Circuit Judges.

Opinion Text

Opinion By:

Smith, Circuit Judge.

This case presents the question whether a patentee is barred by the recapture rule from securing, through reissue, claims to subject matter previously canceled from the original application. Plaintiff-appellee, Ball Corporation (Ball), brought suit against the Government in the United States Court of Claims under 28 U.S.C. §1498(a) (1976) for unauthorized use of the invention claimed in U.S. patent No. Re. 29,296 (July 5, 1977) to Krutsinger, et al. (the Krutsinger patent). The Government moved for summary judgment and Ball filed a cross-motion for summary judgment. Both motions were denied.¹ The Government appealed denial of its motion to this court. At the time of that first appeal, the judgment of the trial judge was not final and the issues had not been certified for appeal. In view of the uncertified, interlocutory nature of the appeal at that time, this court on March 30, 1983, issued an order dismissing the appeal for lack of jurisdiction with leave to seek certification and to appeal pursuant to 28 U.S.C. §1292(d)(2). On November 22, 1983, the trial judge certified the questions. Permission was granted on December 12, 1983, to take interlocutory appeal to this court. The Government again appeals. We conclude that the trial judge properly denied the Government's motion for summary judgment, and we remand the case for trial.

Background

The invention covered by the Krutsinger patent relates to a dual slot antenna assembly [10] (Fig. 1) intended for use on missiles.

Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

The antenna (Fig. 2) consists of two thin cylindrical concentric conductors [20, 24]

assembled so that they are radically spaced slightly apart to form a cavity [18]. The cavity may be void or may be filled with a dielectric material. The axial length of the conductors is substantially equal to one-half wavelength at the anticipated operating frequency of the antenna. The conductor assembly can be mounted around the outer skin of the vehicle (Fig. 1).

The circumferential edges of the cylindrical conductors define radiation slots [23, 25] (Fig. 3).

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Because the cylindrical conductors are one-half wavelength long, these radiation slots are, ipso facto, longitudinally spaced one-half wavelength apart at the anticipated operating frequency of the antenna. The radiation slots are excited by signal energy from a source and cooperate to produce an omnidirectional dipole radiation pattern.² Due to the one-half wavelength spacing between the radiation slots, the electromagnetic radiation emanating from the slots [R 1, R 2] radiates in the same direction and overlaps in an additive manner to provide a stronger radiation pattern.

Signal energy is supplied to the antenna by a connector [70] (Fig. 4).

Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

In the preferred embodiment of the invention, the connection of the inner and outer cylindrical concentric conductive elements to the source is accomplished by means of a single coaxial transmission feedline. It is this feedline element around which the present controversy revolves. In particular, this case involves the number of feedlines to the outer conductor that may be properly claimed in the Krutsinger reissue patent in light of the prosecution history of the original patent application.

The Canceled Claims

Dependent claims 8 and 9 are the only claims of the original application critical to this appeal. Claim 8 includes the single feedline, whereas claim 9 does not. Claim 8 calls for "at least one" conductive lead to be connected to the edge of one of the conductors. Claim 9 requires that "a plurality of leads" be connected to the edge of one of the conductors at circumferentially spaced intervals.

In the first office action on the original application the examiner rejected claims 1-8 and indicated that claims 9 and 10 should be limited to a plurality of feedlines. The claims were amended and, on July 14, 1972, the examiner made his second rejection final. The examiner again suggested the allowability of the plurality of feedlines claims if presented in independent form. The remaining claims were rejected over the newly cited reference, Cork, U.S. patent No. 2,234,234. The Cork patent discloses a single feedline [3] (Fig. 5) and is similar in all other material respects to Krutsinger's antenna. *Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

Following the second office action, Ball added limitations to the claims requiring that a plurality of leads be connected to an edge of the outer conductor. These leads were

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recited to be spaced-apart at intervals substantially

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equal to one wavelength at the anticipated operating frequency of the antenna. Ball also canceled claim 7 and dependent claim 8 (the canceled claims), of the original application, which are set forth below:

7. A dual slot antenna assembly comprising: a first substantially cylindrical conductor, the axial length of which is approximately equal to one-half wavelength at the anticipated operating frequency of said assembly; a second substantially cylindrical conductor, the axial length of which is at least equal to the axial length of said first conductor, said second conductor being positioned concentrically within and radially spaced from said first conductor so as to define a pair of circumstantial slots spaced one-half wavelength apart at said anticipated operating frequency and providing independent radiation patterns emanating in the same direction; and electrical signal feed means connected with said conductor for electrically existing both of said slots.

8. An assembly according to Claim 7 wherein said feed means includes at least one conductive lead which terminates connected to the edge of one of said conductors defining one of said slots.

U.S. patent No. 3,810,183 (the original patent) issued on May 7, 1974, to Ball as assignee, on the basis of the original application, as amended.

Subsequently, Ball decided that it was entitled to claims broad enough to include the single feedline. On July 16, 1975, within the 2-year statutory period for broadened reissue provided in 35 U.S.C. §251, Ball filed a reissue application. Claims 1-4 of the reissue application comprised the four claims of the original patent. New claims 5-7 were added to the reissue application. Only the new claims, 5-7, directed to the single feedline embodiment, are in issue in this proceeding.³

The Alleged Error

In support of its reissue application Ball stated that the original patent was partially inoperative because it claimed less than Ball had a right to claim. Ball identified as error the undue limitation of the claims of the original patent to a plurality of feedlines:

[T]he unwarranted limited scope of our original patent claims were errors [sic] that arose without any deceptive intention as a result of inadequate and/or ineffective communication with our former patent attorney, * * * and/or as a result of an inadequate understanding on our part of the potential effect of recitations in the original patent claim language under United States laws; * * * 4

U.S. patent No. Re. 29,296 issued on July 5, 1977, on the basis of the reissue application.

The Reissue Claims

Ball filed an administrative claim with the United States Navy on January 18, 1978, seeking damages and compensation for unauthorized use of, inter alia, the invention covered by claims 5, 6, and 7 of U.S. patent No. Re. 29,296. Claims 5, 6, and 7 of the reissue patent are set forth below:

5. *A dual slot antenna assembly comprising :*

a pair of laterally spaced-apart conductive elements separated with respect to one

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another by a sheet of dielectric material ,

one of said conductive elements being of larger dimensions and underlying the other element and defining an electrical reference or ground surface ;

said conductive elements defining a pair of radiation slots between opposing edges of said other element and said reference surface, said radiation slots being longitudinally spaced-apart a predetermined distance approximately equal to one-half wavelength at the anticipated operating frequency of said assembly ,

each of which radiation slots emanates radiation therefrom such that the radiation patterns developed are in substantially the same direction ;

said radiation slots having a length dimension equal to the entire length of said opposing edges, which length dimension is greater than the spacing between said conductive elements; and

a single electrical signal feed assembly integrally connected with said other conductive element at only one of said opposing edges for electrically exciting both of said radiation slots from a single signal feed junction .

6. *An assembly according to claim 5 wherein said conductive elements and said sheet of dielectric material each comprise part of a single sheet of dielectric material metallically cladded on opposite sides thereof .*

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7. *An antenna structure comprising :*

an electrically conducting ground surface ,

a single layer electrically conducting surface comprising both an r.f. radiator conducting area and an r.f. feedline conducting area integrally connected thereto and formed therewith ,

a dielectric sheet disposed between said ground surface and the single layer electrically conducting surface ,

said conducting surfaces defining a pair of radiation slots between opposing edges of said r.f. radiator and said ground surface, said radiation slots being longitudinally spaced apart by a predetermined distance approximately equal to one-half wavelength at the anticipated operating frequency of said antenna structure ;

each of which radiation slots emanates radiation therefrom such that radiation patterns developed are in substantially the same direction ;

said radiation slots having a length dimension equal to the entire length of said opposing edges, which length dimension is greater than the spacing between said surfaces; and

said r.f. feedline being connected to the outside edge of one only of said opposing edges of said r.f. radiation conducting area to at least one predetermined point on the periphery of said radiator conducting area . [Emphasis in original.]

On March 25, 1981, Ball filed a petition in the United States Court of Claims under 28 U.S.C. §1498 (1976), ⁵ seeking reasonable and entire compensation for the "infringement" of claims 5, 6, and 7 of U.S. patent No. Re. 29,296. On June 29, 1981, prior to filing an answer, the Government moved for summary judgment. Ball filed a

cross-motion for summary judgment.

Judge Colaiaanni denied both motions. As to the Government's motion, denial of which is on appeal here, the trial judge found that the undisputed evidence of record did not support the Government's arguments; as to Ball's cross-motion, the trial judge found that material issues of fact remained which compelled denial of the motion. Because we agree that neither the recapture rule nor the estoppel doctrine mandate grant of the Government's summary judgment motion, we affirm.

Issues

Two issues are raised in this appeal: (1) whether the error alleged by Ball is sufficient as a matter of law under 35 U.S.C. §251 (1976) to support reissue; and (2) whether Ball is estopped from securing, through reissue, claims covering the single feedline feature.

The Government contends that Ball's deliberate cancellation of the single feedline claims was not error. That act was taken to avoid a prior art rejection and, in the Government's view, the recapture rule bars Ball from securing similar claims through reissue. The Government also contends that the deliberate nature of Ball's acts estops Ball from securing similar claims through reissue. Ball did not appeal the denial of its summary judgment motion but, rather, defends the trial judge's opinion as correct as a matter of law. Resolution of this controversy involves a substantial body of precedent.⁶ The parties differ in their interpretation of the law and in their application of it to the facts of this case.

The Recapture Rule

[1] Reissue is not a substitute for Patent Office appeal procedures. Reissue is an extraordinary procedure and must be adequately supported by the circumstances detailed in

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35 U.S.C. §251 (1976)⁷ and in the implementing regulations, 37 C.F.R. §1.175 (1982). The Government asserts that the nature of error that will justify reissue is narrowly circumscribed to ensure that reissue remains the exception and not the rule. Relying on *Edward Miller & Co. v. Bridgeport Brass Co.*,⁸ the Government contends that "a mere error of judgment" is not adequate to support reissue; rather the error must be "a real bona fide mistake, inadvertently committed."

[2] The 1952 revision of the patent laws made no substantive change in the definition of error under section 251.⁹ While deliberate cancellation of a claim cannot ordinarily be considered error,¹⁰ the CCPA has repeatedly held that the deliberate cancellation of claims *may* constitute error, if it occurs without deceptive intent.¹¹ In *re* Petrow,¹² the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled. Similarly, in *re* Wesseler,¹³ the CCPA stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Thus, the CCPA has construed the term error under section 251 broadly.¹⁴

[3] The Ninth Circuit employed a more rigid standard in *Riley v. Broadway-Hale*

Stores, Inc. ¹⁵ stating: "when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void." The trial judge sought to determine whether Ball has made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from Riley, submits that the trial judge's approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in Riley, in favor of the more liberal approach taken by the CCPA. Petrow clearly establishes the vitality of the standard employed by the trial judge under this court's precedent.

[4] Further, the Government argues that we need not reach the issue of claim scope because the sufficiency of error is a threshold issue. While claim scope is no oracle on intent, the Government fails to apprehend its role. Rarely is evidence of the patentee's intent in canceling a claim presented. Thus, the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available.

Claim scope is not the lodestar of reissue. Rather, the court's reliance on that indicator in the case law appears to be born of practical necessity as the only available reliable evidence.

[5] The Government relies heavily on *Haliczer v. United States* ¹⁶ which also involved

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a suit under 28 U.S.C. §1498. The Court of Claims in that case held the reissue claims invalid because the patentee sought to acquire through reissue the *same* claims that had earlier been canceled from the original application. The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application. ¹⁷ On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the canceled claims. ¹⁸ If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent.

[6] Thus, the applicability of the recapture rule and the sufficiency of error under section 251 turn in this case, in the absence of other evidence of the patentee's intent, on the similarity between the reissue and the canceled claims. Narrower reissue claims are allowable; broader reissue claims or reissue claims of the same scope as the canceled claims are not. ¹⁹ The subject matter of the claims is not alone controlling. ²⁰ Similarly, the focus is not, as the Government contends, on the specific limitations or on the elements of the claims but, rather, on the *scope* of the claims. ²¹

Ball's Reissue Claims

[7] The trial judge required the Government to establish that the applicant has made a deliberate decision that the canceled claims are unpatentable. The Government argues that that standard is not correct because it loses sight of the *feature* that the patentee gave up during prosecution of the original application. We find the Government's argument entirely unpersuasive. The proper focus is on the *scope* of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original

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application. The trial judge quite properly focused on the scope of the claims and we find no error in this respect. He determined that the reissue claims were intermediate in scope -- broader than the claims of the original patent yet narrower than the canceled claims.

The alleged inadequacy of Ball's proffered error is not as clear as the Government contends. The error supporting reissue submitted by Ball comports with the statute and regulations. Further, we fail to perceive the "inconsistency" of Ball's position as asserted by the Government.

The canceled claims, claims 7 and 8, ²² define the invention quite broadly. Canceled claim 8 requires feed means including at least one conductive lead. The reissue claims, ²³ in contrast, include limitations not present in the canceled claims: the cavity is filled with a dielectric material; and an electrical signal feed assembly replaces the feed means of the canceled claims. The electrical signal feed assembly (Fig. 6) is a network of leads with a single coaxial feedline to that network. The network consists of a plurality of thin ribbon-like conductive leads.

Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

Feed points [53] to the outer conductor are one wavelength apart at the anticipated operating frequency of the antenna. The leads of this network [52, 54, 56, 58] are dimensioned to provide continuous impedance matching between the cavity and the single coaxial feedline [70], which feeds into the assembly at the aperture [48]. The signal feed assembly is more limited than the "at least one" feed means limitation of canceled claim 8.

The reissue claims are, however, broader in one respect. The canceled claims are limited to an antenna of cylindrical configuration, whereas the reissue claims are not so limited. We are aware of the principle that a claim that is broader in any respect is considered to

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be broader than the original claims even though it may be narrower in other respects. ²⁴ That rule will not bar Ball from securing the reissue claims here on appeal.

Pursuant to section 251, broadened reissue must be sought within 2 years after issuance of the original patent. The CCPA, in *In re Rogoff*, ²⁵ noted that section 251 contains no exceptions or qualifications as to time or extent of enlargement. The sole issue, therefore, is whether the claims on appeal enlarge, i.e., broaden, the patent claim.

It is well settled that a claim is broadened, so far as the question of right to reissue is concerned, if it is so changed as to bring within its scope any structure which was not within the scope of the original claim. In other words, a claim is broadened if it is broader in any respect than the original claim, even though it may be narrowed in other respects. * * *

[8] Thus, the principle that a claim is broadened if it is broader in any respect than the original claim serves to effect the bar of section 251 against reissue filed later than 2 years after issuance of the original patent. In this case, Ball filed its application for

reissue within the 2-year period for broadened reissue specified in section 251.

[9] We know of no authority applying the above rule to reissue claims relative to the scope of canceled claims within the 2-year period for broadened reissue. Nor do we perceive the wisdom of such extension in this case. The rule is rigid and properly so in that it effects an express statutory limitation on broadened reissue. The recapture rule, however, is based on equitable principles. The rigidity of the broader-in-any-respect rule makes it inappropriate in the estoppel situation presented in this appeal.

Hence, we decline to apply that rule here, where the broader feature relates to an aspect of the invention that is not material to the alleged error supporting reissue. In *Willingham*, the CCPA reversed the rejection of a claim that was narrower than the canceled claim as to one element, although broader as to another element. "The extent to which [deliberate cancellation of a claim from the original application] may also prevent [a patentee] from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation." ²⁶ Accordingly, we hold that the reissue claims are not substantially identical in scope to the canceled claims.

[10] As noted *supra*, there is widespread agreement that reissue claims that are narrower than the canceled claims are allowable. In *In re Wadlinger*, ²⁷ the CCPA faced a situation in which the reissue claims were, as the trial judge found here, of "different" scope from the canceled claims. While both the reissue and canceled claims were directed to the same process in *Wadlinger*, the canceled claims were considered broader, resulting in claims of different scope. The reissue claims were held valid. Similarly, we find that the non-material, broader aspects of Ball's reissue claims do not deprive them of their fundamental narrowness of scope relative to the canceled claims. Thus, the reissue claims are sufficiently narrower than the canceled claims to avoid the effect of the recapture rule.

Estoppel

[11] The Government also argues that Ball is estopped to secure the reissue claims. We do not consider this argument as stating an independent ground for relief. The recapture rule is a creature of equity and it embodies the estoppel notions which the Government now urges upon us. ²⁸ We have already resolved this issue against the Government.

[12] We agree with the patentee that the Government's "file wrapper estoppel" argument is equally unavailing. The doctrine of estoppel based on the prosecution history is a corollary to the doctrine of equivalents, a tool in the analysis of infringement. The parties are before this court purely on a controlling issue of law relative to the validity of the reissue claims being asserted by Ball. There has not yet been a full trial on the issue of infringement, let alone on the validity of the

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reissue claims. ²⁹ The Government's estoppel argument does no more than restate the basic equitable principles underlying the recapture rule.

Conclusion

The trial judge properly articulated the law governing reissue. While broader in scope

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than the original claims, the reissue claims are narrower in scope than the canceled claims. The error supporting reissue appears to be sufficient. On the basis of the facts before us and the reasons given for the cancellation of the claims from the original application, we cannot find, as a matter of law, that Ball is barred from securing reissue claims drawn to the single feedline embodiment of its invention. The case is remanded to the Claims Court for further proceedings consistent with this opinion.

Affirmed and Remanded

Footnotes

Footnote 1. On October 8, 1982, pursuant to this court's order of October 4, 1982, Judge Colaianne of the U.S. Claims Court entered a judgment denying both parties' motions for summary judgment, corresponding to his earlier report in the case, filed by him as a trial judge of the U.S. Court of Claims on August 23, 1982.

Footnote 2. Previous missile antennas exhibited signal nulls that made monitoring difficult from a ground tracking station as the missile rolled or changed direction in flight. The claimed antenna exhibits a substantially isotropic radiation pattern which overcomes this problem by eliminating signal nulls.

Footnote 3. See *Haliczer v. United States*, 356 F.2d 541, 544-45, 148 USPQ 565, 568-69 (Ct. Cl. 1966) (range of equivalents of original patent claims would not include canceled feature).

Footnote 4. See United States Patent and Trademark Office, Manual of Patent Examining Procedure §1401.08 (1974) (error arising from a lack of understanding or of knowledge by applicant's attorney as to the real invention may be acceptable).

Footnote 5. 28 U.S.C. §1498 (1976), as amended by The Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 1982 U.S. CODE CONG. & AD. NEWS (96 Stat.) 25, provides, in pertinent part:

"§1498. Patent and copyright cases

"(a) Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the United States Claims Court for the recovery of his reasonable and entire compensation for such use and manufacture.

"For the purposes of this section, the use or manufacture of an invention described in and covered by a patent of the United States by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States."

Footnote 6. The holdings of the U.S. Court of Claims and of the U.S. Court of Customs and Patent Appeals were adopted as precedent in this court in *South Corp. v. United States*, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982). Both prior courts have ruled on the issues involved in this case. Additionally, several circuit courts have also considered the application of the recapture rule.

Footnote 7. Section 251 provides in pertinent part:

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"§251. Reissue of defective patents

"Whenever any patent is, *through error without any deceptive intention*, deemed wholly or partly inoperative or invalid, * * * by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. * * *

"No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." (Emphasis supplied.)

Footnote 8. *Edward Miller & Co. v. Bridgeport Brass Co.*, 104 U.S. 350, 355 (1882).

Footnote 9. *In re Wadlinger*, 496 F.2d 1200, 1206-07, 181 USPQ 826, 831-32 (CCPA 1974); *In re Wesseler*, 367 F.2d 838, 849, 151 USPQ 339, 347 (CCPA 1966); *In re Byers*, 230 F.2d 451, 454, 109 USPQ 53, 55 (CCPA 1956); *Riley v. Broadway-Hale Stores, Inc.*, 217 F.2d 530, 531 n.1, 103 USPQ 414, 415 n.1 (9th Cir. 1954). But see *In re Willingham*, 282 F.2d 353, 355, 127 USPQ 211, 214 (CCPA 1960). "Error" is interpreted in the same manner as under section 64 of the old law, i.e., accident, inadvertence, or mistake.

Footnote 10. *In re Petrow*, 402 F.2d 485, 487, 159 USPQ 449, 450 (CCPA 1968); *Willingham*, 282 F.2d at 357, 127 USPQ at 215.

Footnote 11. See *Wadlinger*, 496 F.2d at 1206, 181 USPQ at 831; *Petrow*, 402 F.2d at 487, 159 USPQ at 450; *Wesseler*, 367 F.2d at 849, 151 USPQ at 348; *Willingham*, 282 F.2d at 357, 127 USPQ at 215. See also *Tee-Pak, Inc. v. St. Regis Paper Co.*, 491 F.2d 1193, 1201, 181 USPQ 75, 81 (6th Cir. 1974); *Manual of Patent Examining Procedure* §1401.08.

Footnote 12. *Petrow*, 402 F.2d at 488, 159 USPQ at 451. See also *Wesseler*, 367 F.2d at 846, 151 USPQ at 344-46; *Willingham*, 282 F.2d at 357, 127 USPQ at 215-16; *Tee-Pak*, 491 F.2d at 1201, 181 USPQ at 81.

Footnote 13. *Wesseler*, 367 F.2d at 850, 151 USPQ at 349. See also *Riley*, 217 F.2d at 532, 103 USPQ at 415.

Footnote 14. *Wadlinger*, 496 F.2d at 1207-08, 181 USPQ at 832; *In re Richman*, 409 F.2d 269, 273-75, 161 USPQ 359, 362-63 (CCPA 1969); *Wesseler*, 367 F.2d at 849, 151 USPQ at 347-48; *Willingham*, 282 F.2d at 355-56, 127 USPQ at 214. But see *In re Wadsworth*, 107 F.2d 596, 43 USPQ 460 (CCPA 1939).

Footnote 15. *Riley*, 217 F.2d at 532, 103 USPQ at 415.

Footnote 16. *Haliczer*, 356 F.2d 541, 148 USPQ 565.

Footnote 17. *Id.* at 545, 148 USPQ at 569 (bars reissue claims of same scope); *Byers*, 230 F.2d at 455-57, 109 USPQ at 56-57 (bars reissue claims that are of broader scope than canceled claims); *Wadsworth*, 107 F.2d at 599, 43 USPQ at 463 (bars reissue claims of similar scope).

Footnote 18. *Wadlinger*, 496 F.2d at 1204, 181 USPQ at 830, *Petrow*, 402 F.2d at 488, 159 USPQ at 451; *Wesseler*, 367 F.2d at 846-47, 151 USPQ at 346; *Willingham*, 282 F.2d at 356, 127 USPQ at 215.

Footnote 19. If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding.

Footnote 20. Petrow, 402 F.2d at 488, 159 USPQ at 451.

Footnote 21. Richman, 409 F.2d at 274-75, 161 USPQ at 362-63. See also Wadsworth, 107 F.2d 596, 43 USPQ 460 (analysis turns on substantiality of similarity of reissue to canceled claims).

Footnote 22. See supra "The Canceled Claims."

Footnote 23. See supra "The Reissue Claims."

Footnote 24. In re Self, 671 F.2d 1344, 1346, 213 USPQ 1, 3 (CCPA 1982) (reissue application filed 7 years after issuance of original patent); In re Chromy, 318 F.2d 937, 939, 137 USPQ 884, 885 (CCPA 1963) (4 years after issue); In re Price, 302 F.2d 741, 741-42, 133 USPQ 527, 528 (CCPA 1962) (3 years after issue); In re Ruth, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960) (4 years after issue).

Footnote 25. In re Rogoff, 261 F.2d 601, 603-04, 120 USPQ 185, 186 (CCPA 1958).

Footnote 26. Willingham, 282 F.2d at 357, 127 USPQ at 215.

Footnote 27. Wadlinger, 496 F.2d at 1205-06, 181 USPQ at 830-31.

Footnote 28. Reissue is remedial in nature and is based on fundamental principles of equity and fairness. The recapture rule is inherently founded on similar considerations of equity, providing guidance in the application of the law governing reissue. See Wessler, 367 F.2d at 848, 151 USPQ at 347; Willingham, 282 F.2d at 354-55, 127 USPQ at 214.

Footnote 29. The Government apparently misconstrues Haliczzer in this respect. In Haliczzer, the court determined that the doctrine of equivalents would require that the *original* claims, carried over into the reissue patent, would not be entitled to the range of equivalents that were purposely surrendered during prosecution of the *original* patent. This is based on an estoppel notion born of the inconsistency of arguing that the *original* claims cover that which was given up during the prosecution of the original patent. The *reissue* claims, not the original claims, are in issue here and the Government's reasoning is, therefore, inapposite. There is no inconsistency in arguing the broadened scope of the reissue claims and, thus, no estoppel.

- End of Case -

Hester Industries Inc. v. Stein Inc. (CA FC) 46 USPQ2d 1641

Hester Industries Inc. v. Stein Inc.

**U.S. Court of Appeals Federal Circuit
46 USPQ2d 1641**

**Decided May 7, 1998
Nos. 97-1352, -1353**

Headnotes

PATENTS

1. Practice and procedure in Patent and Trademark Office -- Reissue -- Error without deceptive intent (§ 110.1303)

Asserted reissue claims of patent for food cooker are broader than original claims within meaning of "recapture rule," which prohibits grant of reissue claims that are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution, since reissue claim that does not include limitation present in original patent claims is broader in that respect, and since reissue claims in present case do not include two limitations of original claims that require cooking "solely with steam," supplied by "two sources of steam."

2. Practice and procedure in Patent and Trademark Office -- Reissue -- Error without deceptive intent (§ 110.1303)

Arguments made to overcome prior art, even when made in absence of any claim amendment, can evidence admission sufficient to give rise to finding of "surrender" within meaning of "recapture rule," which prohibits grant of reissue claims that are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution, since view that arguments alone can give rise to surrender is consistent with policy behind reissue statute, 35 USC 251, which is based on fundamental principles of equity and fairness, and with accompanying recapture rule, which is based on principles of

equity and therefore embodies notion of estoppel.

3. Practice and procedure in Patent and Trademark Office -- Reissue -- Error without deceptive intent (§ 110.1303)

Applicant surrendered claim scope for food cooker patent that does not include two limitations which require cooking "solely with steam," supplied by "two sources of steam," since applicant repeatedly argued, during prosecution of original patent, that "solely with steam" and "two sources of steam" limitations distinguished original claims from prior art, and that each of these limitations was "critical" to patentability, and since these repeated arguments constitute admission by applicant that limitations were necessary to overcome prior art.

4. Practice and procedure in Patent and Trademark Office -- Reissue -- Error without deceptive intent (§ 110.1303)

Determining whether subject matter surrendered by argument alone during prosecution of original patent has crept back into asserted reissue claims is accomplished by simply analyzing asserted reissue claims to determine whether they were obtained in manner contrary to arguments on which surrender was based; in present case, in which asserted reissue claims of patent for food cooker do not include two original claim limitations, which required cooking "solely with steam" supplied by "two sources of steam," surrendered subject matter, namely cooking other than solely with steam and with at least two sources of steam, has crept into reissue claims.

5. Practice and procedure in Patent and Trademark Office -- Reissue -- Error without deceptive intent (§ 110.1303)

Asserted reissue claims of patent for food cooker, which are broader in certain respects than claims of original patent, have not been materially narrowed in other respects so as to avoid operation of "recapture rule," since limitation in reissue claims requiring use of "high humidity steam" is actually same as or broader than corresponding limitation in original claim, since limitation in reissue claims requiring use of "spiral conveyance path" for conveyor belt of device is not materially limiting, in view of corresponding means-plus-function limitation in original claim, and since "spiral conveyance path" and "high humidity steam" limitations are not aspects of invention that were overlooked during prosecution of original patent.

6. Practice and procedure in Patent and Trademark Office -- Reissue -- Same invention (§ 110.1305)

"Original patent" clause of reissue statute, 35 USC 251, does not include separate requirement of objective intent to claim; rather, essential inquiry is whether one skilled in art, reading specification, would identify subject matter of new claims as invented and disclosed by patentee, and to extent construct of objective intent to claim is useful, it is only one factor which sheds light on whether original

patent clause is satisfied.

Particular patents -- General and mechanical -- Cooker

Re. 33,510 (of 4,582,047), Williams, high humidity steam cooker with continuously running conveyor, judgment of invalidity affirmed.

Re. 33,259 (of 4,582,047), Williams, high humidity steam cooker with continuously running conveyor, judgment of invalidity affirmed.

Case History and Disposition:

Page 1642

Appeal from the U.S. District Court for the Eastern District of Virginia, Ellis, J.; 43 USPQ2d 1236

Action by Hester Industries Inc. against Stein Inc. for patent infringement. Plaintiff appeals from grant of defendant's motion for summary judgment of patent invalidity, and defendant cross-appeals from pre-trial ruling in which district court adopted plaintiff's proposed claim construction. Summary judgment of invalidity affirmed; cross-appeal dismissed.

Attorneys:

Robert W. Adams, Robert A. Vanderhye, James T. Hosmer, Robert W. Faris, and William J. Griffin, of Nixon & Vanderhye, Arlington, Va., for plaintiff-appellant.

Charles H. De La Garza, of Arnold, White & Durkee, Minneapolis, Minn.; L. Gene Spears and James C. Pistorino, Houston, Texas, for defendant-cross appellant.

Judge:

Before Plager and Schall, circuit judges. 1

Opinion Text

Opinion By:

Plager, J.

Hester Industries, Inc. ("Hester") appeals from a summary judgment of invalidity entered by the

United States District Court for the Eastern District of Virginia. The district court ruled that the reissue patent claims asserted by Hester against Stein, Inc. ("Stein") are invalid for failing to meet the statutory "error" and "original patent" requirements for reissue patents set forth in 35 U.S.C. Section 251 Para. 1 (1994). *Hester Indus., Inc. v. Stein, Inc.*, 963 F. Supp. 1403 [43 USPQ2d 1236] (E.D. Va. 1997). Stein cross-appeals a pretrial oral ruling in which the district court adopted Hester's proposed construction of the claim term "high humidity steam."

Because the asserted reissue claims impermissibly recapture subject matter surrendered by Hester through deliberate arguments repeatedly made to the Patent Office to overcome prior art, we hold that Hester is barred from asserting "error" within the meaning of 35 U.S.C. Section 251 Para. 1. We accordingly affirm the summary judgment of invalidity. Because the asserted claims are invalid, we need not and do not reach the claim construction issue.

BACKGROUND

At issue in this case are two reissue patents, U.S. Patent No. Re. 33,510 (the "'510 reissue patent") and U.S. Patent No. Re. 35,259 (the "'259 reissue patent"). The two patents are reissues of the same original patent, U.S. Patent No. 4,582,047 (the "'047 patent" or "original patent"), which they replaced pursuant to 35 U.S.C. Section 251. 1 The patents are directed to a high humidity steam cooker having a continuously running conveyor for cooking food items such as poultry and other meat products. Hester, a processor of pre-cooked poultry and other meat products, owns the patents, and Charles E. Williams ("Williams"), a Hester employee, is the sole named inventor. After the '259 reissue patent (the second reissue) issued in 1996, Hester sued Stein, a manufacturer of industrial appliances, for allegedly infringing several reissue claims in the two reissue patents.

The two reissue patents and the original patent have the same written description; the patents differ only with respect to their claims. That written description describes an industrial-size steam cooker for cooking large quantities of food products. The cooker is described as having a cooker chamber in which a steam atmosphere is maintained. The food products are carried through the cooker chamber on a conveyor belt that runs through a spiral path. The written description teaches that efficient cooking is achieved without the loss of humidity, flavor, or appearance by maintaining a water-drop-free steam atmosphere within the chamber at near 100 degrees C and 100% humidity, at above atmospheric pressure.

Two separate sources of steam, one internal and one external, are described for maintaining

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the steam atmosphere. The internal source of steam described is a pool of water on the floor of the cooker chamber, heated by a heating element in the pool. The external source described is a steam generator, located outside the cooker chamber and connected by pipes to various locations within the cooker chamber to inject steam at those locations. The written description states that the external steam source typically provides 25% of the steam, with the remainder provided by the internal source. '047 patent, col. 3, ll. 42-45, 57-59. The heating element in the internal steam source is controlled to maintain the desired amount of steam and pressure within the cooker chamber. *Id.* col. 3, ll. 59-63.

The section of the written description entitled DETAILED DESCRIPTION OF THE PREFERRED

EMBODIMENT describes the cooking atmosphere thus:

The cooking is solely with water droplet free steam near 100 degrees C. and 100% humidity at a pressure above atmospheric. The high humidity atmosphere prevents losses of humidity of the product as it passes through the cooker and helps retain juices, essences and flavor of the product. Also it improves the heating steam interface heat exchange at the product surface for more efficient cooking.

The higher pressure not only produces a pressure-cooker like cooking efficiency to the cooking process, but is critical in connection with the flavor and conveyor type product flow as well.

Id. col. 3, ll. 22-33.

The original patent contains one independent claim, claim 1, directed to a food cooking system. The claim specifies that the cooking system cooks solely with steam and that the system includes two sources of steam to provide the steam atmosphere. Characteristics of the steam atmosphere are set forth, and the cooking system is said to include a means passing a conveyor belt through the cooker housing. Claim 1, with relevant text emphasized, reads:

A food cooking system *cooking solely with steam* foods such as fish, fowl, meats or produce carried through a cooker on a continuously running conveyor belt, comprising in combination, a cooker housing, *means passing said conveyor belt through said housing* to expose food products within the cooker housing only to *said steam as the sole cooking medium*, and *two sources of steam providing said steam* to cook the food products, nozzles for releasing steam located inside said housing, one comprising a steam generator supplying supplemental steam into said housing at said nozzles located therein *to maintain the atmosphere together with the other steam source at near 100% humidity 100 degrees C. and a pressure above atmospheric*, and the other source of steam comprising a pool of water within said housing with heating means for boiling the water to create steam.

Id. col. 5, l. 59 to col. 6, l. 8. For purposes here, this is substantially the same form in which the claim was first filed (as application claim 1) in the application for the original patent. Accordingly, we do not distinguish between the issued claim and the application claim, but instead simply refer to claim 1.

In addition to the independent claim, the original patent contains several claims which are dependent upon claim 1. Relevant here is dependent claim 12, which specifies in pertinent part: "A system as defined in claim 1 *wherein the conveyor belt is passed* inside said housing *in a spiral path* coiling downwardly. . . ." *Id.* col. 6, ll. 59-61 (emphasis added). This claim stemmed from original application claim 16, which specified that the conveyor belt is "passed . . . in a spiral path."

The application for the '047 patent (the original patent) was filed in 1979. The patent did not issue until 1986, nearly seven years later. Over the almost seven years in which the application was prosecuted before the United States Patent and Trademark Office ("Patent Office"), inventor Williams, through his attorney, repeatedly emphasized the "solely with steam" and "two sources of steam" features of the claimed invention in attempting to establish patentability over the prior art. For example, after the Examiner first rejected claim 1 as well as all the other claims as obvious, Office Action of Feb. 6, 1980, at 2, Williams distinguished a cited prior art cooker that cooked with a combination of infra-red dry heat and steam on the ground that the claimed invention cooked solely with steam, stating: "This principle is completely different from applicant's invention where the claims define cooking *solely* with steam."

Applicant Response of Apr. 28, 1980 (emphasis in original). Williams also distinguished claim 1 on the basis of the "two sources of steam" limitation, the specified

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characteristics of the steam atmosphere, and the recited continuously running conveyor belt. *Id.*

Application claim 16, which specified a spiral conveyance path, was rejected as obvious in view of an additional prior art cooker that included a spiral conveyor. Office Action of Feb. 6, 1980, at 4. In response, Williams amended claim 16 to specify further details of the spiral conveyance path and then argued that the claimed spiral conveyance path was distinguished from that shown in the prior art. Applicant Response of Apr. 28, 1980.

However, the Examiner continued to reject all claims as obvious. Office Action of July 9, 1980. At that point, Williams placed even greater reliance on the "solely with steam" and "two sources of steam" limitations in an attempt to overcome the obviousness rejection. For example, in his first appeal of the obviousness rejection to the Board of Patent Appeals and Interferences ("Board"), Williams stated, "The claimed system cooks *solely* with steam . . . by means of two separate and critical steam sources. . . ." Applicant Brief on Appeal, at 2 (Aug. 20, 1980) (emphasis in original). Later in the same brief, Williams specifically distinguished the cited prior art on the basis of these limitations:

The primary reference Vischer cooks with IR radiation not steam. Clearly the claimed feature of cooking *solely* with steam is directly contrary to the teaching of the Vischer patent, which could therefore never make obvious any process or equipment cooking *solely* with steam as claimed.

....

The Examiner errs in any implication that Jourdan shows two sources of steam.

Id. at 9-10 (emphasis in original).

Prior to the Board hearing Williams' appeal, the Examiner reopened prosecution on the merits in view of newly discovered prior art, thereby removing the appeal from the Board. 2 Office Action of Mar. 17, 1981. The Examiner then rejected all of the claims as obvious over the new prior art. *Id.* In response, Williams distinguished claim 1 over that prior art on the same bases, *i.e.*, the "solely with steam" and "two sources of steam" limitations. Applicant Response to Office Action (Apr. 17, 1981). However, the Examiner was not persuaded, even after these same arguments were repeated in subsequent papers submitted to the Patent Office.

Accordingly, Williams initiated a second appeal to the Board. He again emphasized the "solely with steam" and "two sources of steam" limitations. Applicant Brief on Appeal, at 13 (Dec. 22, 1981). He explained that the two sources of steam interact to provide a "synergy" that is "novel and nowhere suggested in any of the cited [prior] art." *Id.* Williams drove home his reliance on the "solely with steam" limitation most forcefully in his reply brief to the Board: "Clearly the Examiner reversibly errs as a matter of fact and in his efforts to make a case out against the *very material claimed feature that steam is the sole cooking medium (claim 1)*. Thus reversal is respectfully solicited." Applicant Reply Brief on Appeal, at 6 (Sep. 30, 1982) (emphasis in original).

The Board was persuaded and accordingly reversed the obviousness rejection in its opinion dated

June 21, 1985, stating:

[W]e find no suggestion in the combined teachings of the references which would have led the ordinarily skilled worker in the art to an apparatus utilizing steam as the sole cooking medium; utilizing two separate sources of steam, one of which includes a pool of water in the cooking chamber with means for boiling the water; and wherein the atmosphere within the cooking chamber is maintained above atmospheric by the two sources of steam.

Thereafter the claims were allowed and the application issued as the '047 patent on April 15, 1986.

On the two-year anniversary of the '047 patent's issuance, Williams applied for a reissue pursuant to 35 U.S.C. Section 251, alleging that the patent claims had been drawn too narrowly due to attorney error. In the required oath accompanying the reissue application, Williams explained that he became aware of this alleged error after learning that Stein was in the process of developing a competing cooker in early 1988. According to his oath, Williams and his employer Hester concluded that the '047 patent should cover the Stein cooker, notwithstanding the fact that the cooker used a non-steam heat source and only one source of steam in the cooking process. Williams further explained that Hester's present counsel advised Hester that the '047 patent claims, as written, might not cover Stein's cooker. Thus, Williams, by oath, declared that the patent was insufficient because it claimed less than he had a right to claim.

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Specifically, Williams identified two relevant deficiencies of the '047 patent, as follows (indentation and numbering added): 3

[1] that each of claims 1-14 therein requires cooking "solely with steam" and exposing food products within the cooker housing "only to said steam as the sole cooking medium". . . . [and] [2] that each of claims 1-14 therein requires "two sources of steam providing said steam to cook the food products, nozzles for releasing steam located inside said housing"[]

These deficiencies, according to Williams, "arose after [he] executed and filed the original application from which the '047 patent issued" and were caused by "the failure of [his prior] patent attorney . . . to appreciate the full scope of [his] invention."

This application ripened into the '510 reissue patent nearly three years later on January 1, 1991. However, prior to its issuance, Williams filed a second reissue application, for reasons not relevant here, on June 21, 1990, alleging the same errors used to support the first reissue. Six years later, this second reissue application issued as the '259 reissue patent. Hester then filed this action, accusing Stein of infringing two claims in the first reissue patent and six claims in the second. Specifically, Hester accused Stein of infringing reissue claims 26 and 59 of the '510 reissue patent and reissue claims 28, 30, 31, 32, 75, and 76 of the '259 reissue patent.

The requirement in original claim 1 that cooking is "solely with steam" is absent from each of the asserted reissue claims. Also absent is the "two sources of steam" limitation. Rather, the asserted reissue claims merely recite a source of steam or at least one source of steam. None of the asserted reissue claims explicitly recite the steam atmosphere characteristics specified in original claim 1, *i.e.*, the

characteristics of near 100 degrees C and 100% humidity at above atmospheric pressure. Instead, all but one of the asserted reissue claims recite "high humidity steam." 4

Claim 26 of the '510 reissue patent is representative of the two asserted reissue claims in that patent. It provides in pertinent part:

A food cooking system for cooking food products carried on a moving conveyor belt, comprising:
a cooker housing[,]
means disposed within said housing for defining a conveyance path ,
a conveyor belt disposed along said conveyance path for supporting and conveying said food products along said path,

means coupled to said belt for causing said belt and said food products supported thereby to substantially continually translate along said conveyance path . . . , and *a source of steam providing steam to contact and cook the food products, said steam source comprising at least one of the following*
:

an external steam generator supplying steam into said housing, and

a pool of water within said housing with heating means communicating with said pool of water for creating steam. . . . [,] *wherein said steam source provides high humidity steam* and said food products are directly exposed to said high humidity steam.

'510 patent, col. 8, ll. 8-31, 36-38 (emphasis added, and text of claim 24, upon which claim 26 depends, incorporated).

The asserted reissue claims of the '259 reissue patent are, for purposes here, substantially similar. One difference is that several of these claims explicitly recite a "spiral conveyance path." Claim 28, which is representative, provides in pertinent part:

A spiral steam cooker for at least partially cooking exposed food products, said cooker comprising:
a housing defining an internal volume therein;

a conveyor belt at least partially *disposed along a spiral conveyance path* within said internal volume . . . ; and *a steam source* operatively coupled to said housing, said steam source *providing a high humidity steam atmosphere* within said internal volume, said high humidity steam atmosphere directly contacting and at least partially cooking the exposed food products

'259 patent, col. 9, l. 61 to col. 10, l. 12 (emphasis added).

Before the district court, Stein moved for summary judgment that the asserted reissue claims are invalid for failing to meet the requirements of the reissue statute, 35 U.S.C. Section 251. That section (with emphasis added) reads:

Whenever any patent is, through *error* without any deceptive intention, deemed wholly or

partly inoperative or invalid, by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent* , the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent *for the invention disclosed in the original patent* , and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

In particular, Stein argued that the "error" requirement of Section 251 Para. 1, as well as the requirement therein that the reissue claims be "for the invention disclosed in the original patent" (the "original patent" requirement), were not met. With regard to the "error" requirement, Stein argued that Williams had not erred in including the "solely with steam" and "two sources of steam" limitations in the original claims, and further argued that the removal of those limitations violated the "recapture" rule. Stein further argued that the asserted reissue claims violated the "original patent" requirement because, Stein asserted, the original patent does not evidence an "objective" intent to claim the invention in the manner of the asserted reissue claims.

The district court granted Stein's motion. The court first concluded that there was no "error" as contemplated by Section 251 Para. 1. Specifically, the court concluded that the alleged failure of counsel to appreciate the scope of the invention was belied by the clear language in the original patent claims, the prosecution history of the patent, and the absence of any explanation as to the nature or cause of the attorney's failure to appreciate the full scope of the invention. *Hester* , 963 F. Supp. at 1408. The court did not reach Stein's assertion that the asserted reissue claims violate the recapture rule, though the court relied heavily on the original patent's prosecution history in determining that the "error" requirement was not met. *See id.* at 1409-11.

The district court ruled that the asserted reissue claims are alternatively invalid for failing to meet the "original patent" requirement. *Id.* at 1412. The district court concluded that the "original patent" clause of Section 251 Para. 1 includes a separate requirement that the original patent manifest an "objective" intent to claim the invention as later claimed on reissue. *Id.* at 1412-13. The court concluded that the original patent does not manifest such an objective intent, and thus the claims are also invalid under the "original patent" clause of Section 251 Para. 1. *Id.* at 1412-15.

In its appeal of the invalidity judgment, Hester argues that the district court erred in concluding that the "error" and "original patent" requirements of Section 251 Para. 1 were not met. Stein, in seeking to uphold the judgment, makes the same arguments presented to the district court in its motion for summary judgment. Hester, on the other hand, argues that the "error" requirement was met by way of prior patent counsel's failure to appreciate the full scope of the invention. Hester further asserts that the recapture rule is inapplicable because the reissue claims were never presented during prosecution of the original patent and later abandoned by amendment or cancellation. With regard to the "original patent" clause of Section 251 Para. 1, Hester submits that there is no separate requirement of a manifestation of an objective intent to claim.

Also at issue on appeal is the district court's resolution of a "Motion For Claim Interpretation" brought by Stein. In that motion, Stein argued that the claim term "high humidity steam" should be construed in accordance with the only specific description of the steam atmosphere provided in the patents, *i.e.* , as water-droplet-free steam near 100 degrees C and 100% humidity at above atmospheric pressure. Hester, relying on the opinion of its expert, proposed a broader construction, arguing that the description contained in the patents is merely one example of "high humidity steam."

The district court, in a ruling delivered from the bench prior to holding the asserted reissue claims invalid, adopted Hester's proposed construction of the claim term. The ruling was never reduced to a formal order or judgment. The parties, by way of cross-appeal by Stein, present the same issue on appeal.

DISCUSSION

I

In reviewing the summary judgment of invalidity, we keep in mind that summary judgment is appropriate only when the record shows that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of

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law." Fed. R. Civ. P. 56(c). Whether the statutory requirements of 35 U.S.C. Section 251 have been met is a question of law. *See In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997). This legal conclusion can involve underlying factual questions. *See id.*

II

As previously explained, the "error" and "original patent" requirements at issue here are found in the first paragraph of Section 251. The "error" requirement limits the availability of a reissue patent to certain correctable errors. *See In re Amos*, 953 F.2d 613, 616, 21 USPQ2d 1271, 1273 (Fed. Cir. 1991). As seen in the above-emphasized text of Section 251, one such correctable error is the patentee claiming his invention too broadly or too narrowly. *See id.*

The "original patent" requirement is a second and independent requirement, *see Amos*, 953 F.2d at 615, 21 USPQ2d at 1272, which restricts a reissue patent to "the invention disclosed in the original patent." 35 U.S.C. Section 251 Para. 1. We address each of these requirements in turn.

A

1

In considering the "error" requirement, we keep in mind that the reissue statute is "based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). We also keep in mind that "not every event or circumstance that might be labeled 'error' is correctable by reissue." *Id.* Indeed, the reissue procedure does not give the patentee the right "to prosecute *de novo* his original application." *Id.* at 1582, 229 USPQ at 677; *see also Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. *See Amos*, 953 F.2d at 616, 21 USPQ2d at 1273; *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of Section 251. *See Clement*, 131 F.3d at 1468, 45

USPQ2d at 1163; *Wilder*, 736 F.2d at 1519, 222 USPQ at 371. Williams asserted this form of error as the basis for his reissue applications, and the Patent Office accepted his assertion as adequate.

However, the district court concluded that there was no such error by Williams' attorney. *Hester*, 963 F. Supp. at 1411. In reaching this conclusion, the court was particularly persuaded by the prosecution history of the original patent. The court concluded that the attorney's repeated attempts to distinguish Williams' invention on the basis of the "solely with steam" and "two sources of steam" limitations belied Williams' assertion that his attorney failed to appreciate the full scope of his invention. *Id.* at 1409-11. The court also determined that there was no other form of Section 251 "error" and thus held the asserted reissue claims invalid. *Id.* at 1411-12.

2

We share the district court's discomfort with Williams' attempt to remove, through reissue, the "solely with steam" and "two sources of steam" limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art. This concern is addressed most squarely by the "recapture rule," recently discussed at length in *Clement*, 131 F.3d 1464, 45 USPQ2d 1161. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1525.

In its motion for summary judgment, Stein presented the recapture rule as one basis for finding the asserted reissue claims invalid, and Stein repeats this argument on appeal as one basis for affirming the summary judgment of invalidity. While the district court did not explicitly rule on this ground, its opinion indicates the view that Hester, through the reissue patents, recaptured surrendered subject matter. *Hester*, 963 F. Supp. at 1412 (stating that through the reissues, Hester obtained claims covering

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"ovens with characteristics repeatedly distinguished and disclaimed in the PTO" and that that was contrary to the "error" requirement of Section 251). As will be next explained, we conclude that the asserted reissue claims violate the recapture rule and that the summary judgment ruling is appropriately affirmed on this ground.

[1] "Under [the recapture] rule, claims that are 'broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution' are impermissible." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164 (quoting *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims. See *id.* A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See *id.* Here, it is undisputed that the asserted reissue claims are broader than the original patent claims in that the reissue claims do not include the "solely with steam" and "two sources of steam" limitations found in each of the original patent claims.

Having determined that the reissue claims are broader in these respects, under the recapture rule we

next examine whether these broader aspects relate to surrendered subject matter. *See id.* at 1468-69, 45 USPQ2d at 1164. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments* and changes to the claims made in an effort to overcome a prior art rejection." *Id.* at 1469, 45 USPQ2d at 1164 (emphasis added). This statement in *Clement* indicates that a surrender can occur by way of arguments *or* claim changes made during the prosecution of the original patent application. To date, the cases in which this court has found an impermissible recapture have involved claim amendments or cancellations. *See, e.g., id.* at 1469-70, 45 USPQ2d at 1164-65; *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25. However, in addition to the suggestion in *Clement* that argument alone can effect a surrender, this court expressly left open that possibility in *Ball Corp. v. United States*: "If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding." 729 F.2d 1429, 1436 n.19, 221 USPQ 289, 295 n.19 (Fed. Cir. 1984). Prior to this case, this court has not squarely addressed the question.

This court's prior opinions indicate that, as a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. *See Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164 (noting that, with regard to claim amendments, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable); *Mentor*, 998 F.2d at 995, 27 USPQ2d at 1524 (same); *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984) (declining to apply the recapture rule when there was no evidence that the "amendment . . . was in any sense an admission that the scope of [the] claim was not patentable"). In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable. *See Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25 (finding surrender by way of claim amendments); *Ball*, 729 F.2d at 1436, 221 USPQ at 294 (noting that a court may draw inferences from changes in claim scope).

[2] Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. Indeed, in *Mentor* and *Clement* the findings of a surrender were based in part on the arguments made in conjunction with the claim amendments. *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Clement*, 131 F.3d at 1470-71, 45 USPQ2d at 1165-66. Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is not the only permissible predicate for establishing a surrender.

The view that arguments alone can give rise to a surrender is consistent with the policy behind the reissue statute and the accompanying recapture rule. As already noted, the reissue statute is "based on fundamental principles of equity and fairness." *Weiler*, 790 F.2d at 1579, 229 USPQ at 1675. There is no unfairness in binding the patentee to deliberate assertions made in order to obtain allowance of the original patent claims over the prior art. Indeed, fairness to the public must also be considered. In this regard, as stated in *Mentor*, "the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 USPQ2d at 1525. The recapture rule operates to prevent this from happening. *See*

id. Furthermore, as recognized in *Ball*, the recapture rule is based on principles of equity and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 USPQ at 296.

Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 1051 [41 USPQ2d 1865] (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. See *id.*

Hester argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another -- reissue allows an expansion of patent rights whereas prosecution history estoppel is limiting. However, Hester's argument is unpersuasive. The analogy is not to the broadening aspect of reissues. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art. See, e.g., *Texas Instruments, Inc. v. International Trade Comm'n*, 998 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993). The same reasoning that led us to conclude that arguments alone can give rise to prosecution history estoppel lends support to the proposition that arguments alone can give rise to a surrender for purposes of the recapture rule.

Thus we conclude that, in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with respect to the "solely with steam" and "two sources of steam" limitations, the pertinent aspects in which the asserted reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

[3] As detailed above, Williams repeatedly argued that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less than 27 places in six papers submitted to the Patent Office, Williams asserted that the "solely with steam" limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the "two sources of steam" limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was "critical" with regard to patentability, and Williams further stated that the "solely with steam" limitation was "very material" in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations.

[4] Having concluded that there has been a surrender, we must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. See *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164. When the surrender occurs by way of claim amendment or cancellation, "[c]omparing the reissue claim with the canceled claim is one way to do this." See *id.* This analysis is not available when the surrender is made by way of argument alone. Instead, in this case, we simply

analyze the asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.

Clearly they were. None of the asserted reissue claims include either the "solely with steam" limitation or the "two sources of steam" limitation. Thus, this surrendered subject matter -- *i.e.*, cooking other than solely with steam and with at least two sources of steam -- has crept into the reissue claims. The asserted reissue claims are unmistakably broader in these respects.

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. *See, e.g.*, *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. For example, in *Ball* the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue

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claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

[5] However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by the addition of the "spiral conveyance path" and "high humidity steam" limitations. The term "high humidity steam" is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term "high humidity steam" is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere "at near 100% humidity 100 degrees C. and a pressure above atmospheric." '047 patent, col. 6, ll. 3-4. Hester concedes that the term "high humidity steam" is not narrower than this limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of "high humidity steam." Accordingly, the use of the term "high humidity steam" does not save the reissue claims from the recapture rule.

The term "spiral conveyance path" is also not materially limiting. This term appears explicitly in asserted reissue claims 28, 32, 75, and 76 of the '259 reissue patent; it does not appear explicitly in the other reissue claims asserted. Original claim 1 includes a corresponding limitation, namely, "means passing said conveyor belt through said housing. . . ." This is a so-called means-plus-function clause drafted pursuant to 35 U.S.C. Section 112 Para. 6 (1994). 6 According to Section 112 Para. 6, the clause is to be construed to "cover the corresponding structure . . . described in the specification and equivalents thereof." The only corresponding structure described in the specification (more properly, the written description of the patent) passes the conveyor belt through a spiral path. *See* '047 patent, col. 4, l. 64 to col. 5, l. 8. Thus, the explicit recitation of a "spiral conveyance path" in some of the asserted reissue claims does not materially narrow those claims. Indeed, Hester does not explain how the explicit recitation of a spiral conveyance path--which is present in prior art cookers cited by the examiner during the prosecution of the original patent--materially narrows these claims. In sum, neither alone nor

together do the terms "high humidity steam" and "spiral conveyance path" materially narrow the claims.

Furthermore, the "spiral conveyance path" and "high humidity steam" limitations are not aspects of the invention that were overlooked during prosecution of the original patent. To the contrary, as just explained, these aspects were included in original claim 1. Additionally, with regard to the "spiral conveyance path" limitation, original dependent claim 12 explicitly recites "a spiral path." '047 patent, col. 6, l. 60. In prosecuting the original patent, Williams pointed out these features in an attempt to overcome the Examiner's obviousness rejection. Hester cannot now argue that Williams overlooked these aspects during the prosecution of the original patent application. In conclusion, this is not a case which involves the addition of material limitations that overcome the recapture rule.

In effect, Hester, through eight years of reissue proceedings, prosecuted Williams' original patent application anew, this time placing greater emphasis on aspects previously included in the original patent claims and removing limitations repeatedly relied upon to distinguish the prior art and described as "critical" and "very material" to the patentability of the invention. The reissue statute is to be construed liberally, but not that liberally. The realm of corrections contemplated within Section 251 does not include recapturing surrendered subject matter, without the addition of materially-narrowing limitations, in an attempt to 'custom-fit' the reissue claims to a competitor's product.

No doubt if two patent attorneys are given the task of drafting patent claims for the same invention, the two attorneys will in all likelihood arrive at somewhat different claims of somewhat different scope. And such differences are even more likely when, as here, the second attorney drafts the new claims nearly a decade later and with the distinct advantage of having before him the exact product offered by the now accused infringer. This reality does not justify recapturing surrendered subject matter under the mantra of "failure to appreciate the scope of the invention." The circumstances of the case before us simply do not fit within the concept of "error" as contemplated by the

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reissue statute. See *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("Error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted.").

With respect to the recapture issue, there are no underlying material facts as to which there is a genuine issue in dispute. The original patent's prosecution history, on which we rely, is before us and undisputed. All that remains is the ultimate legal conclusion as to whether the asserted reissue claims fail to meet the "error" requirement because the claims impermissibly recapture surrendered subject matter. See *id.* at 994, 27 USPQ2d at 1524 (stating that whether the "error" requirement has been met is a legal conclusion). For the reasons explained above, we conclude as a matter of law that the asserted reissue claims fail in this regard. Summary judgment of invalidity of the asserted reissue claims under Section 251 is called for. Accordingly, we affirm the district court's entry of summary judgment.

B

As an alternative basis for holding the asserted reissue claims invalid, the district court concluded that the reissue claims do not meet the "original patent" clause of Section 251 Para. 1, which requires that the reissue patent be "for the invention disclosed in the original patent." *Hester*, 963 F. Supp. at 1412. In reaching this conclusion, the court interpreted the "original patent" clause as requiring an

"objective" intent, manifested in the original patent, to claim the invention as claimed in the reissue patent. *Id.* The court based this interpretation on the Supreme Court's statement in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 676 [53 USPQ 6] (1942), that there was an objective intent requirement under the predecessor reissue statute, 35 U.S.C. Section 64 (1964), which required that the reissue patent be "for the same invention." *Id.* at 1413.

Based on this construction of the "original patent" clause, the district court framed the issue as, "whether the 047 patent manifests an objective intent to cover ovens that utilize heat sources other than steam, and have less than two steam sources." *Id.* The district court concluded that the asserted reissue claims failed to meet this test and thus were invalid under the "original patent" clause. *Id.* at 1413-15. On appeal, the parties focus on whether the "original patent" clause embodies the requirement of an objective intent to claim.

[6] This court squarely addressed the issue in *Amos*, 953 F.2d at 616, 21 USPQ2d at 1273. The *Amos* court held that Section 251 does not include a separate requirement of an objective intent to claim. 953 F.2d at 618-19, 21 USPQ2d at 1275-76. Rather, the court concluded: "the essential inquiry under the 'original patent' clause of Section 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." *Id.* at 618, 21 USPQ2d at 1275. The court noted that this inquiry is analogous to the "written description" requirement of 35 U.S.C. Section 112 Para. 1 (1994). *Id.* The court further stated that, to the extent the construct of an objective intent to claim is useful, it is "only one factor that sheds light" on whether the "original patent" clause of Section 251 is satisfied. *Id.* at 619 & n.2, 21 USPQ2d at 1275-76 & n.2 (quoting *In re Hounsfield*, 699 F.2d 1320, 1323, 216 USPQ 1045, 1047-48 (Fed. Cir. 1983)).

With regard to the Supreme Court's opinion in *U.S. Industrial*, 315 U.S. 668, the *Amos* court noted that that case was decided under the predecessor reissue statute which required reissue claims to be for the "same invention," and concluded that *U.S. Industrial* does not now mandate a separate "objective intent to claim" requirement. *Id.* The *Amos* court noted that this court reached the same conclusion eight years earlier in *Hounsfield*, 699 F.2d at 1323, 216 USPQ at 1047-48. *Id.*

Thus, the district court's conclusion that the "original patent" clause of Section 251 was not satisfied based on an "objective intent to claim" requirement was in error. Stein does not contend that the test set forth in *Amos* for the "original patent" clause -- i.e., whether one skilled in the art would identify the subject matter of the reissue claims as invented and disclosed by the patentee -- is not met by the asserted reissue claims. Rather, Stein relies entirely on its assertion that there is an "objective intent to claim" requirement and that that requirement is not met. However, we need not resolve this issue further, having already concluded that the asserted reissue claims are invalid for failing to meet the "error" requirement of Section 251.

III

Finally, Stein presents to us the question of whether the district court properly construed the claim term "high humidity steam." It is not immediately apparent whether this issue is properly before us. The

district court did not construe the term in conjunction with a final judgment, such as a summary

judgment of noninfringement or invalidity. Rather, the district court issued an oral ruling on the matter in preparation for trial. However, the district court having held the asserted claims invalid on summary judgment, which we here affirm, there can be no question of liability and hence the claim construction issue is moot. Therefore, we need not decide whether Stein's appeal of the claim construction is proper, and if so, whether the district court's construction was correct.

CONCLUSION

We affirm the grant of summary judgment of invalidity of the asserted reissue claims for failure to comply with 35 U.S.C. Section 251 Para.1. Stein's cross-appeal is dismissed.

COSTS

Each party shall bear its own costs.

AFFIRMED .

Footnotes

Footnote 1. The district court noted that the issuance of two reissue patents for the same original patent was a "curiosity" that appeared to be unprecedented. *Hester* , 963 F. Supp. at 1405 n.2. However, the propriety of two reissues for the same patent was not addressed below and has not been raised on appeal. Accordingly, we express no opinion on the matter.

Footnote 2. Accordingly, the Board never heard Willams' first appeal.

Footnote 3. The reissue oath specifies two further insufficiencies, namely, that the '047 patent requires:

[3] "a steam generator supplying supplemental steam into said housing at said nozzles located thereinside to maintain the atmosphere together with the other steam source at near 100% humidity 100 degrees C and a pressure above atmospheric" and [4] "a pool of water within the housing with heating means for boiling the water to create steam."

(Indentation and numbering added.)

Footnote 4. Claim 30 of the '259 reissue patent does not contain the "high humidity steam" language.

Footnote 5. The last paragraph of Section 251 requires that a request to enlarge the scope of claims be "applied for within two years from the grant of the original patent." 35 U.S.C. Section 251 Para. 4 (1994).

Footnote 6. Use of the word "means" in a claim clause triggers a presumption that Section 112 Para. 6 applies. See *York Prods., Inc. v. Central Tractor Farm & Family Ctr.* , 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1623-24 (Fed. Cir. 1996). The presumption can be overcome if the clause recites

sufficient structure. *See id.* The clause at issue here recites no structure for performing the function of passing the conveyor belt through the housing. Accordingly, Section 112 Para. 6 unquestionably applies.

Footnote 1. A member of the panel that heard argument in this case was unable to continue with consideration of the case because of recusal. Pursuant to Rule 47.11 of this court, the matter was decided by the remaining members of the panel.

- End of Case -